

REMARKS

This is responsive to the Office Action mailed February 7, 2007. Withdrawal of the finality of the Office Action mailed February 7, 2007 is respectfully requested. Reinstatement and allowance of withdrawn claims 5-11, 19-26, and 29 is respectfully requested. Reconsideration and allowance of claims 1-4 and 13-17 is respectfully requested.

The Status of the Claims

Claims 5-11, 19-26, and 29 stand withdrawn by the Examiner as being allegedly directed to an invention different from the originally presented invention.

Claims 1-4 and 13-17 stand rejected under 35 U.S.C. § 102(b) as being allegedly anticipated by Schenck, U.S. Patent No. 5,561,371 (hereinafter "Schenck").

Claim 12 is indicated as containing allowable subject matter.

The Constructive Restriction is Improper and Should be Withdrawn

Applicants wholly agree that the originally presented invention was constructively elected by original presentation of claims 1-28 for prosecution on the merits. The initial Office Action stated "Claims 1-28 are rejected under 35 U.S.C. § 102(b) as being anticipated by Schenck P.N. 5,561,371." Office Action mailed August 23, 2006, at page 2. In making this statement, the Examiner represented that he examined each and every claim 1-28 individually on the merits, and found each and every claim 1-28 individually anticipated by Schenck. Therefore, the originally presented invention on which Applicants received an action is precisely defined by the set of individual claims 1-28 that were examined in the Office Action mailed August 23, 2006, where each dependent claim incorporated by reference each and every limitation of its specified base claim or base claims.

Claim 5 as presently constituted is precisely and exactly directed to the originally presented invention. Amendment A amended claim 5 only in rewriting claim 5 in independent form including all limitations of the base claims, and by removing the preamble clause "for a magnetic resonance imaging apparatus". This preamble clause is a statement of intended use and carries no patentable weight. MPEP § 2111.02 ("If the body of a claim fully and intrinsically sets forth all of the limitations of the claimed invention, and the preamble merely states, for example, the purpose or intended use of the invention, rather than any distinct definition of any of

the claimed invention's limitations, then the preamble is not considered a limitation and is of no significance to claim construction"). Therefore, claim 5 as presently constituted is the originally presented invention, and cannot be properly constructively restricted as being allegedly directed to something other than the originally presented invention.

Claim 6-11 depend from claim 5, and were not amended in any way in Amendment A. Accordingly, these claims also are directed to precisely and exactly the originally presented invention, and cannot be properly constructively restricted as being allegedly directed to something other than the originally presented invention.

Claim 19 as presently constituted is precisely and exactly directed to the originally presented invention. Amendment A amended claim 19 only in rewriting claim 19 in independent form including all limitations of the base claims. Claim 19 as presently constituted is the originally presented invention, and cannot be properly constructively restricted as being allegedly directed to something other than the original invention.

Claim 20 was not amended in previous Amendment A, and depends from claim 19. Accordingly, claim 20 as presently constituted is the originally presented invention, and cannot be properly constructively restricted as being allegedly directed to something other than the original invention.

Claims 21-24 and 26 are amended only in their dependency changing from canceled claim 18 to claim 19. Claim 29 is a newly added claim depending from claim 19. Accordingly, claims 21-24, 26, and 29 overlap in scope (specifically, are encompassed by) claim 19 which is precisely and exactly directed to the originally presented invention.

Claim 25 as presently constituted is precisely and exactly directed to the originally presented invention. Amendment A amended claim 25 only in rewriting claim 25 in independent form including all limitations of the base claims. Claim 25 as presently constituted is the originally presented invention, and cannot be properly constructively restricted as being allegedly directed to something other than the original invention.

For the foregoing reasons, Applicants respectfully submit that the withdrawal of claims 5-11, 19-24, 26, and 29 was improper, and respectfully request that these claims be reinstated and reconsidered in the forthcoming Office Action.

Applicants Request Reconsideration of Claims 1 and 13

In previous Amendment A, Applicants wrote:

[T]he primary coil of Schenck includes only half-turns, which does not produce a fingerprint-patterned primary coil. Moreover, since Schenck teaches designing the coil by folding a conceptual fingerprint-patterned primary coil across the lines B-B and B'-B', the primary coil of Schenck inherently has only half-turns, which are not combinable to form a fingerprint pattern.

Amendment A at page 10.

The present Office Action states "applicant appears to admit that Schenck's coil is indeed a fingerprint coil, the suggestion is that the coil somehow ceases to be a fingerprint coil because Schenck uses a folded design." Office Action at page 4.

This statement confuses apparatus with design of the apparatus. Applicants do not admit that Schenck's coil is a fingerprint coil. The term "conceptual fingerprint-patterned primary coil" relates to a design concept that never physically exists. It is not accurate to say that the fingerprint ceases to be a fingerprint coil because of the folded design – there never was a fingerprint coil in the first place.

The Office Action further states that "[e]ven if one looks at half of the gradient coil of Schenck (primary coil) the pattern of coil conductors can be reasonably described as a fingerprint coil." *Id.* Applicants respectfully disagree. The term "fingerprint" is defined in a standard dictionary as follows:

or variant.

finger post *n.* A guidepost in the shape of a pointing hand.

fin·ger·print (fing'gar-print') *n.* **1.** An impression on a surface of the curves formed by the ridges on a fingertip, especially such an impression made in ink and used as a means of identification. **2.** A distinctive or identifying mark or characteristic: "the invisible fingerprint that's used on labels and packaging to sort out genuine products from counterfeits" (Gene G. Marcial). —**fingerprint** *tr.v.* **-print-ed, -print-ing, -prints.** **1.** To take the fingerprints of. **2.** To identify by means of a distinctive mark or characteristic.

fin·ger·spell·ing (fing'gar-spél'ing) *n.* Communication by means of a manual alphabet. —**fin·ger·spell'** *v.*

fin·ger·tip (fing'gar-tip') *n.* The extreme end or tip of a finger. —**idiom.** at (one's) **finger-tips.** Readily available.

finger wave *n.* A wave set into dampened hair using only the fingers and a comb.

fin·i·al (fin'e-al) *n.* **1.** *Architecture.* An ornament fixed to the



fingerprint

The American Heritage Dictionary of the English Language, 3rd edition (Houghton Mifflin, 1992).

At most, the pattern of Schenck's primary coil might be called a "half-fingerprint". Claim 1 calls for a fingerprint-patterned primary coil defining an inner cylindrical surface, not a half-fingerprint-patterned coil.

Finally, the Office Action states that "[t]he examiner cannot ascribe patentable weight to a feature that provides the same function but 'appears' different to the eye." Office Action at page 4. To the contrary, it is precisely what "appears different to the eye" that is, the structure, that must be given patentable weight in an apparatus claim such as claim 1, and not the function. MPEP § 2114 (While features of an apparatus may be recited either structurally or functionally, claims directed to an apparatus must be distinguished from the prior art in terms of structure rather than function). Moreover, claim 1 is rejected under 35 U.S.C. § 102(b) – accordingly, the reference must either expressly show or inherently describe each and every element as set forth in the claim. Schenck does not disclose a fingerprint-patterned primary coil.

(This foregoing is not to say that the coil of claim 1 is functionally identical with the coil of Schenck. Applicants do not admit that the coil of Schenck provides the same functionality as the coil of claim 1. To the contrary, the present application quantitatively identifies a minimum stored energy that is achievable by including some isolated primary coil turns, that is, by having a fingerprint-patterned primary coil rather than a half-fingerprint-patterned primary coil such as in Schenck. See Amendment A at page 9.)

Claim 13 calls for a generally cylindrical cold shield coaxially aligned with the outer cylindrical surface and having a larger cylindrical radius than the outer cylindrical surface. Applicants do not find in Schenck a cold shield, much less a cold shield as specified in claim 13. To reject a claim under 35 U.S.C. § 102(b), each and every element as set forth in the claim must be found, either expressly or inherently described, in the single applied reference. Applicants respectfully request that the forthcoming Office Action or Advisory Action identify a cold shield in Schenck, or alternatively request that the rejection of claim 13 under § 102(b) be withdrawn.

For at least the foregoing reasons, it is respectfully submitted that claims 1-4 and 12-17 patentably distinguish over Schenck. Accordingly, Applicants respectfully request reconsideration and allowance of claims 1-4 and 12-17.

The Finality of the Office Action is Premature and Should be Withdrawn

As set forth herein, Applicants respectfully submit that the withdrawal of claims 5-11, 19-24, 26, and 29 was improper. These claims should be reinstated and reconsidered in view of Applicants remarks as set forth in previous Amendment A.

As additionally set forth herein, Applicants respectfully submit that Schenck does not anticipate claims 1-4 and 12-17 because Schenck does not either expressly show or inherently describe each and every element set forth in the claims.

For at least the foregoing reasons, Applicants respectfully request withdrawal of the finality of the present Office Action to enable full re-consideration of all claims 1-17, 19-26, and 29.

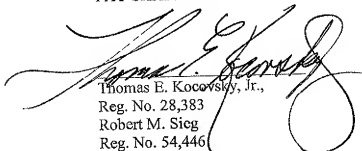
CONCLUSION

Based on the foregoing, Applicants respectfully request withdrawal of the finality of the Office Action mailed February 7, 2007, reinstatement and allowance of withdrawn claims 5-11, 19-26, and 29, and reconsideration and allowance of claims 1-4 and 13-17.

In the event the Examiner considers personal contact advantageous to the disposition of this case(s), he is requested to telephone Thomas E. Kocovsky or Robert M. Sieg at (216) 861-5582.

Respectfully submitted,

FAY SHARPE LLP

A large, stylized handwritten signature in black ink, which appears to read "Thomas E. Kocovsky, Jr.", is written over the printed name and address.

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